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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
07/957,080	10/07/92	CORR	S 97766/CPR366

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11M1/0520

EXAMINER

OGDEN, N

ART UNIT

PAPER NUMBER

1105

25

DATE MAILED:

05/20/97

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**UNITED STATES DEPARTMENT OF
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 25

Serial Number: 07/957,080

Filing Date: 10/07/92

Appellant(s): Corr

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GROUP 1100

Paul N. Kokulis
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to appellant's reply brief on appeal
filed 3-27-95.

Claim Rejections - 35 USC § 112

1. Claim 1 rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of applicant's amendment.

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Response to argument.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

In response to Applicant's argument that the prior art does not include certain features of Applicant's invention, the limitations on which the Applicant relies (i.e., the solubility of the lubricant in the refrigerant(s)) are not stated in the claims. Therefore, it is irrelevant whether the reference includes those features or not.

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there

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must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, It would have been obvious to one of ordinary skill in the refrigerant art to include the mixture of pentafluoroethane and difluoromethane to the liquid composition of Jolley because Shankland et al teach that said composition mixture may be used in a method for producing refrigerant comprising the azeotrope-like compositions and thereafter evaporating the refrigerant in the vicinity of the body to be cooled (col. 4, lines 47-52). Furthermore, as Jolley teaches that a mixture of said refrigerants such as fluoromethanes and fluoroethanes may be employed in said refrigerant/lubricant

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compositions, one of ordinary skill in the art would expect similar results with the employment of a mixture of conventional fluorine containing refrigerants in the absent of unexpected results.

Appellant further argues that Jolley does not specifically mention either R-32 or R-125 or mixtures thereof. The examiner contends, Jolley teaches the inclusion of fluorine containing refrigerants's and their equivalences and since the secondary references teach R-32 and R-125 as effective refrigerants which further comprise lubricants (as do the Jolley formulations) it would have obvious that said refrigerants were known as conventionally used refrigerants at the time of the instant invention. Therefore, it would appear that one skilled in the refrigerant/lubricant art would expect the composition of Jolley to exhibit similar or beneficial results with the inclusion of typical fluorine refrigerants such as R-32 or R-125, absent a showing of criticality.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Paul Lieberman", with a long horizontal flourish extending to the right.

**PAUL LIEBERMAN
SUPERVISORY PRIMARY EXAMINER
ART UNIT 115**

np
May 15, 1997

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